



IFW PAC  
Atty. Dkt. No. 054769-2001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: CHIANG et al.  
Title: FLUORESCENCE ENERGY  
TRANSFER BY  
COMPETITIVE  
HYBRIDIZATION

Appl. No.: 09/031,087

Appl. Filing Date: 2/26/1998

Examiner: Tung

Art Unit: 1656

<b>CERTIFICATE OF MAILING</b> I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below.  <u>Vanessa E. Agha</u> (Printed Name)  <u>Vanessa E. Agha</u> (Signature)  <u>December 27, 2005</u> (Date of Deposit) <b>RECEIVED</b>
--

JAN 04 2005

OFFICE OF PETITIONS

**PETITION TO REVIVE AND REQUEST FOR CONTINUED EXAMINATION (RCE)**  
**TRANSMITTAL**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Petition to Revive and a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

Enclosed are:

- [ X ] Petition for Revival of Application for Patent Abandoned Unintentionally under 37 C.F.R. § 1.137(b) (4 pgs.);
- [ X ] Submission Accompanying a Request for Continued Examination under 37 C.F.R. § 1.114 (13 pgs.);
- [ X ] Table I (annotated sheet) (1 pg.);
- [ X ] Table I (replacement sheet) (1 pg.);
- [ X ] Sequence Listing Paper Copy (2 pgs.);

12/30/2005 NGBREH1 00000033 500872 09031087  
01 FC:1801 790.00 DA  
02 FC:1253 1020.00 DA

☒ Computer Disc Containing Sequence Listing (1 disc);

☒ Statement to Support Filing and Submission in Accordance with 37 C.F.R. §§ 1.821-1.825 (1 pg.).

The filing fee is calculated below:

	Claims as Amended	Previously Paid For	Extra Claims Present	Rate	Fee Totals
RCE Fee 1.17(e):				\$790.00	= \$790.00
Total Claims:	19	- 20	= 0	x \$50.00	= \$0.00
Independents	1	- 3	= 0	x \$200.00	= \$0.00
First presentation of any Multiple Dependent Claims:				+ \$360.00	= \$0.00
CLAIMS FEE TOTAL:					= \$790.00

☒ Applicant hereby petitions for an extension of time under 37 C.F.R. §1.136(a) for the total number of months checked below:

<input type="checkbox"/>	Extension for response filed within the first month:	\$120.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the second month:	\$450.00	\$0.00
<input checked="" type="checkbox"/>	Extension for response filed within the third month:	\$1,020.00	\$1,020.00
<input type="checkbox"/>	Extension for response filed within the fourth month:	\$1,590.00	\$0.00
<input type="checkbox"/>	Extension for response filed within the fifth month:	\$2,160.00	\$0.00
EXTENSION FEE SUBTOTAL:			\$1,020.00
EXTENSION FEE ALREADY PAID:			\$0.00
EXTENSION FEE TOTAL			\$1,020.00
CLAIMS AND EXTENSION FEE TOTAL:			\$1,810.00
<input type="checkbox"/>	Small Entity Fees Apply (subtract ½ of above):		\$0.00
<input checked="" type="checkbox"/>	Petition fee to Revive Unintentionally Abandoned Application		\$1500.00
TOTAL FEE:			\$3,310.00

☒ Please charge Deposit Account No. 50-0872 in the amount of \$3,310.00. A duplicate copy of this transmittal is enclosed.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date 12/27/2005

By Barry Wilson

FOLEY & LARDNER LLP  
Customer Number: 30542  
Telephone: (858) 847-6722  
Facsimile: (858) 792-6773

Richard Warburg, Reg. No. 32,327  
By Barry S. Wilson, Reg. No. 39,431  
Attorney for Applicant



Atty. Dkt. No. 054769-2001

**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: CHIANG et al.  
Title: FLUORESCENCE ENERGY  
TRANSFER BY COMPETITIVE  
HYBRIDIZATION  
Appl. No.: 09/031,087  
Filing Date: 02/26/1998  
Examiner: Tung, J.  
Art Unit: 1639

<b>CERTIFICATE OF MAILING</b> I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below.  <u>Vanessa E. Agha</u> (Printed Name)  <u>Vanessa E. Agha</u> (Signature)  <u>December 27, 2005</u> (Date of Deposit)
---

**RECEIVED**

JAN 04 2005

**OFFICE OF PETITIONS**

**PETITION FOR REVIVAL OF APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Petition requests that the above-identified patent application be revived on the basis that its abandonment was unintentional.

Mr. Wayne Brown, Chief Patent Counsel for the assignee of the above referenced application, brought this file to the attention of Foley & Lardner LLP for a status evaluation in late October of 2005. The file history shows that Mr. Steven Weiss, patent counsel for Quest Diagnostics, was prosecuting this application. Mr. Weiss left his employment at Quest Diagnostics in late April of 2001. He was replaced by Mr. Brown who joined Quest Diagnostics in early April of 2001. Mr. Brown's employment and that of Mr. Weiss's overlapped by about 2 weeks.

Mr. Brown indicated to the undersigned that when he joined Quest Diagnostics, he learned that it was the corporate practice to have all or nearly all of the patent files handled by outside counsel. He also was aware that an outside U.S. patent firm was handling world-wide prosecution of the family of applications of which the instant application belongs. Mr. Brown

indicated that to the best of his knowledge, he was not aware that the instant application had been prosecuted internally by Quest Diagnostics and was not aware that the application had become abandoned.

Mr. Brown recently became curious about the status of the instant application after receiving correspondence from the outside patent counsel handling the filings related to the instant application. Mr. Brown then sent the original file at Quest Diagnostics to Foley & Lardner LLP for a status evaluation in late October of 2005.

The undersigned reviewed the file but could not determine the status because the last communication in the file was an Office Action mailed on 12/09/1999. The undersigned filed a Power of Attorney by Assignee on October 31, 2005. A Notice of Acceptance of Power of Attorney was mailed on 11/17/2005. A Power to Inspect the file was filed on 11/17/2005 and a copy of the file history was subsequently obtained and mailed to the undersigned.

A review of the USPTO file history showed that it contained an Interview Summary mailed 07/31/2000 and a Notice of Abandonment mailed 09/22/2000. The undersigned verified that these two mailings were not present in the original file received from Quest Diagnostics.

The Interview Summary shows that Examiner Tung contacted Mr. Steven Weiss, attorney for the Assignee, on 07/31/2000. The recorded substance of the interview indicates that the application "was not going to be abandoned."

The undersigned was able to contact with Mr. Weiss at the end of November of 2005 to obtain any available information about the instant application. Mr. Weiss indicated that he had no recollection of the patent application nor any relevant files.

Beginning in December of 2005, the undersigned reviewed the outstanding Office Action and prepared a responsive communication addressing all issues. The responsive communication and a Request for Continued Examination (RCE) accompany this petition to revive.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Required reply and/or fee;
- (2) Petition fee (37 C.F.R. § 1.17(m));
- (3) Statement that the abandonment was unintentional; and
- (4) Any required terminal disclaimer (37 C.F.R. § 1.137(c)).

1. Required reply and/or fee.

The proposed reply and fee for three months extension of time is filed herewith in the form of an Amendment in Response to the Office Action mailed 12/09/1999 with authorization to charge the extension of time.

2. Petition fee (37 C.F.R. § 1.17(m))

Authorization is given to charge the fee required under 37 C.F.R. § 1.17(m) to cover the fee for this petition.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872.

3. Statement that the abandonment was unintentional.

Applicant hereby states that the entire delay in filing the required reply, from the due date for the reply until the filing of this petition, was unintentional.

4. Any required terminal disclaimer (37 C.F.R. § 1.137(c)).

No terminal disclaimer is required in this application under 37 C.F.R. § 1.137(c) since this application was not filed before June 8, 1995.

Respectfully submitted,

Date December 27, 2005

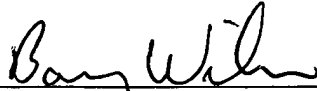
FOLEY & LARDNER LLP

Customer Number: 30542

Telephone: (858) 847-6700

Facsimile: (858) 792-6773

By



Richard J. Warburg

Attorney for Applicant

Registration No. 32,372

By Barry S. Wilson

Reg. no. 39,431